REMARKS

Claims 1-98 were pending. Claims 1-54 and 97 were rejected. Claims 55-96 and 98 were withdrawn. By virtue of this response, claims 2, 4, 26, and 27 are cancelled, claims 1, 3, 5-7, 12, 21, 22, 24-25, 28-30, 35, 44, 45, 47, 48, 50-54, and 97 are amended, and new claims 99-101 are added. Accordingly, claims 1, 3, 5-25, 28-54, 97, and 99-101 are currently under consideration.

No new matter was added by virtue of amendment to existing claims and addition of new claims. Amendment and cancellation of claims is to be construed as dedication or abandonment of any subject matter.

For the Examiner's convenience, Applicants' remarks are presented in the same order in which they were raised in the Office Action.

Claim Rejections Under 35 USC §102

Claims 1-54, and 97 are rejected under 35 U.S.C. 102(e) as being allegedly anticipated by Bailey et al. U.S. Patent No. 6,785,671 B1 (herein after Bailey).

In support of the rejection of claim 1, the Examiner cited Column 2, Lines 30-44 of Bailey. This portion of Bailey apparently teaches, "a method for displaying the results of a multiple-category search according to levels of significance of the categories to a user's search query." "In a preferred embodiment, the method involves receiving a search query from a user and identifying, within each of multiple item categories, a set of items that satisfy the query. The sets of items are then used to generate, for each of the multiple categories, a score that indicates a level significance or relevance of the category to the search. The scores may be based, for example, on the number of hits (items satisfying the query) within each category relative to the total number of items in that category, the popularity levels of items that satisfy the query, or a combination thereof." Column 2, Lines 30-44, emphasis added. By contrast, claim 1 recites in part "determining relative responsiveness, compared with other members of the search result set, of the document to the search term."

Also, the Examiner cited Column 18, Lines 13-17 of Bailey. However, this section of Bailey does not teach or suggest "determining relative responsiveness...based on the sales information and on a position of the document in an ordering of the search result set" as recited in amended claim 1.

Because a valid rejection for anticipation requires that a single reference teach every limitation of a claim and Bailey does not so teach, Applicants submit that amended claim 1 is not anticipated by Bailey and Applicants respectfully request withdrawal of the rejection against claim 1.

Claims 2 and 4 are cancelled.

Claims 3, and 5-23 depend from claim 1 and thereby incorporate all limitations of claim 1. At least for this reason, claims 3 and 5-23 are allowable over Bailey and Applicants request withdrawal of the rejection against these claims.

Claims 97 and 99-101 depend from claim 1. Each of claim 97 and 99-101 is directed to an inventive aspect which Applicants submit is not taught by Bailey. By virtue of dependence from allowable claim 1 and by virtue of additional limitations recited in each respective claim, Applicants request allowance of claims 97 and 99-101.

Claim 24 is to a computer readable medium and recites in part "instructions for estimating responsiveness of the document to the search term based on the sales information and on a position of the document in an ordering of the plurality of members of the search result set." Applicants submit that this recitation in claim 24 is not taught by Bailey. Applicants request withdrawal of the rejection against claim 24.

Claims 25, and 28-46 each depend directly or indirectly from claim 24 and thus incorporate all limitations of claim 24. At least for this reason, claims 28-46 are allowable over Bailey and Applicants respectfully request withdrawal of the rejection against claims 28-46.

pa-1029375

Claim 47 is to an apparatus, and recites in part, "logic for determining relative responsiveness, compared with other members of the search result set, of the document to the search term based on the sales information and on a position of the document in an ordering of the search result set." This recitation in claim 47 is not taught by Bailey. Applicants request withdrawal of the rejection against claim 47.

Claims 48-54 each depend from claim 47 and thus incorporate all limitations of claim 47. At least for this reason, claims 48-54 are allowable over Bailey and Applicants respectfully request withdrawal of the rejection against claims 48-54.

Applicants respectfully request a full examination of the claims dependent from independent claims 1, 24, and 47. In particular, the Examiner has not provided any reference(s) that allegedly teaches or suggests additional limitations recited in each of claims 5-23 and 28-46. 35 U.S.C. 102(e) provides in part that "a person shall be entitled to a patent unless the invention was described" in particular patents or patent applications. See 37 C.F.R. 1.104, "in rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command." Thus, in the absence of any such reference(s) rejection of these dependent claims is inappropriate. Applicants acknowledge that objection may have been appropriate, which would have provided Applicants, in this present response, an opportunity to produce allowable independent claims therefrom. See MPEP 706.01, "[i]f the form of the claim (as distinguished from its substance) is improper, an objection is made."

Claim Rejections Under 35 USC §101

Claims 1-23, and 97 were rejected under 35 U.S.C. 101, allegedly because the claimed invention is directed to non-statutory subject matter.

The Examiner's basis for finding that claims 1-23 and 97 are directed to non-statutory subject matter may be found at pages 7-8 of Paper No. 08052005. The Examiner stated, in part, "State Street never addressed...the technological arts test established in *Toma*" in arguing that the "technological arts" test is a valid basis for rejection under 35 U.S.C. 101. The Examiner further

relied on the non-precedential Board of Patent Appeals and Interferences (BPAI) decision in *Ex parte Bowman* 61 USPQ2d (BNA) 1669 (BPAI 2001) for further support of the "technological arts" basis for rejection under 35 U.S.C. §101. The Examiner concluded that "these claims [presumably claims 1-23 and 97] fail to recite the specific and non-trivial application of technology in the body of the claims." The Examiner has not alleged a failure to satisfy the *State Street* useful, tangible and tangible result test, or that the claims raise any *Diamond v. Diehr* exceptions.

Based on the above, the Applicants submit that the Examiner is of the opinion that there is a separate "technological arts" test for determining whether claims are directed to statutory subject matter, and that the Examiner used this "technological arts" test as the sole basis for rejecting, under 35 USC §101, claims 1-23 and 97. In the recent and precedential opinion *Ex Parte Lundgren* 76 USPQ2d (BNA) 1285 (BPAI September 28, 2005), the BPAI determined that "there is no currently judicially recognized separate technological arts test to determine patent eligible subject matter under §101." Therefore, at least because of this recent precedent established by the BPAI clarifying that the "technological arts" test is not recognized, the 35 USC §101 rejection against claims 1-26 and 97 finds no basis for support. Applicants respectfully request withdrawal of this rejection.

Prior art made of record and not relied upon

Applicants note that the Examiner made reference to various prior art references in concluding on pages 8-9 of Paper No. 08052005. However, the Examiner did not make a showing of how any of those references made of record, alone or in combination with other references, establishes a basis for rejecting any of the pending claims.

pa-1029375

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 324212003600. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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Respectfully submitted,

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pa-1029375